

Attached herewith is a Form PTO-1449 listing references that should be considered during examination. In accordance with 37 CFR § 1.98(d), copies of the listed references are not provided because they were cited by the Office in U.S. Appln. Nos. 09/056,927 and 09/362,089, which are relied upon for an earlier filing date.

This IDS is intended to be in full compliance with the rules. But should the Examiner find any part of its required contents to have been omitted, prompt and early notice to that effect is earnestly solicited, along with additional time pursuant to 37 CFR § 1.97(f), to allow Applicants to comply fully.

Applicants are mindful of the large number of references that have been cited during prosecution of this application and have been provided to examiners involved in this and related applications. These references have come to Applicants' attention during multiple lawsuits involving patents that relate to the present application and the normal course of prosecution. Applicants have cited them to fulfill their duty of disclosure. In an effort to make reviewing these references manageable for the Examiner, Applicants have provided the PTO with multiple copies of two compact discs (CDs) with the references available for viewing or searching electronically.

Applicants' representative, Mr. Philip McGarrigle, has provided the CDs to Group Director John Doll, Supervisory Primary Examiners Michael Woodward and Gary Jones, and Special Program Examiner Cecilia Tsang. The CDs given to Messrs. Doll, Woodward, and Jones were for distribution to individual Examiners within their respective groups. The CDs presented to Examiner Tsang were to accompany the hard copies of the references in the IDS which are in a central location in her office and are intended to be available to all examiners assigned to

these applications. The Examiner is invited to contact the undersigned if further copies are needed.

Of the two CDs that make up the IDS, one contains the articles/other documents and the other contains the patents/published patent applications. The CD containing the articles is in PDF format and can be viewed by selecting the appropriate article as discussed below. The CD containing patents has both a version with text and a version with appropriate figures. It is fully searchable and contains a program that has the ability to search for specific terms or to use Boolean logic to formulate more specific searches. There are links within each full text patent to the patents that are cited therein.

The vendor who prepared the patent CD suggests that the README.HTML file in the root directory of the CD be opened before use. It contains directions on how to use the CD, as well as a hyperlink to the patent list. The CD that contains the articles suggests that "Index" or "Index2" be opened to view the images. Lists of articles are provided as Forms PTO-1449 and can be opened by clicking on the hyperlinked number of the article in the left hand column.

Applicants would also like to inform the Examiner of *inter partes* matters that relate to this application. Two commonly owned patents U.S. Patent Nos. 5,744,305 and 5,800,992 have been involved in interference proceedings. Specifically, they were Interference No. 104,359 between commonly owned U.S. Patent No. 5,744,305 and Brown et al., U.S. Appn. No. 08/688,488, and Interference No. 104,358 between commonly owned U.S. Patent No. 5,800,992 and U.S. Appn. *Brown et al.* No. 08/514,875. Both interferences have been decided (subject to current appeal in the District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior Party challenged the patents on the basis of lack of

enablement and written description under 35 USC § 112, among other issues.

The Junior Party's initial position is set out in papers (with supporting information) entitled "Request for Declaration of Interference, 37 C.F.R. § 1.608" in both interferences. The initial response of the Senior Party and Patentee is set out in papers (with supporting information) entitled "Fodor's Opposition to Brown's Rule 608(b) Request" in both interferences.

Furthermore, U.S. Patent Nos. 5,744,305 and 5,800,992 are the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymetrix. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CFR § 1.132, and arguments made during prosecution) have been raised. These allegations are denied. Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding has been brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 619,321. Collectively, these proceedings have generated a considerable number of references, which were cited on the information disclosure statement and CD-ROMs discussed above. On request, Applicants can provide copies of litigation documents that may be of interest to the Examiner, but have not done so at the present time due to the extensive nature of the multiple litigations and papers filed therein.

As provided by 37 CFR §§ 1.97(g) and (h), no inference should be made that this information and the listed references are prior art merely because they

have been submitted for consideration. Furthermore, no representation is being made that a search has been conducted or that this statement encompasses all possible material information.

Consideration of the foregoing and attachments are earnestly solicited. The Examiner is invited to contact the undersigned if further information is needed.

Respectfully submitted,

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